

SOLICITOR

AO 120 (Rev. 2/99)

AUG 11 2008

TO: Mail Stop 8
 Director of the U.S. Patent & Trademark Office
 P.O. Box 1450
 Alexandria, VA 22313-1450

REPORT ON THE
 FILING OR DETERMINATION OF AN
 ACTION REGARDING A PATENT OR
 TRADEMARK

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Northern District of California on the following Patents or Trademarks:

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
CV 08-03726 EMC	8/4/08	450 Golden Gate Avenue, P.O. Box 36060, San Francisco, CA 94102
PLAINTIFF	DEFENDANT	
ADVANCED SEMICONDUCTOR ENGINEERING, ET AL.	TESSERA, INC.	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 see Complaint		
2 5,663,106		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY	<input type="checkbox"/> Amendment	<input type="checkbox"/> Answer	<input type="checkbox"/> Cross Bill	<input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK			
1					
2					
3					
4					
5					

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
Richard W. Wierking	Sheila Rash	August 5, 2008

Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

1 ROBERT E. CAMORS, JR., CA BAR NO. 121204
2 bobcamors@thelen.com
3 PAPOOL S. CHAUDHARI, CA BAR NO. 241346
4 pchaudhari@thelen.com
5 THELEN REID BROWN RAYSMAN & STEINER LLP
6 225 West Santa Clara, 12th Floor
7 San Jose, California 95113-1723
8 Telephone: (408) 292-5800
9 Facsimile: (408) 287-8040

10 Attorneys for Plaintiffs
11 ADVANCED SEMICONDUCTOR ENGINEERING, INC., ASE TEST LIMITED, and ASE
12 (U.S.), INC.

E-FILING

ADR
UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

13 ADVANCED SEMICONDUCTOR ENGINEERING, INC., ASE TEST LIMITED, and ASE (U.S.) INC,

14 Plaintiffs,

15 vs.

16 TESSERA, INC.,

17 Defendants.

ORIGINAL
FILED

08 AUG -4 PM 3:30

RICHARD W. WIEKING
CLERK
U.S. DISTRICT COURT
NO. DIST OF CA S.J.

C Case No.: 08 03726

COMPLAINT FOR
DECLARATORY JUDGMENT
OF NON-INFRINGEMENT AND
INVALIDITY OF U.S. PATENT
NO. 5,663,106

DEMAND FOR JURY TRIAL

EMC

18
19
20
21
22
23
24
25
26
27
28

COMPLAINT

Plaintiffs Advanced Semiconductor Engineering, Inc., ASE Test Limited, and ASE (U.S.) Inc. (collectively “ASE”) for its Complaint against Tessera, Inc. (“Tessera”) herein allege:

NATURE OF ACTION

1. This is an action for declaratory relief arising under the Patent Act of the United States, 35 U.S.C. §100 et. seq., regarding non-infringement and invalidity of United States Patent No. 5,663,106 (“106 Patent”). A copy of the ’106 Patent is attached hereto as Exhibit A.

PARTIES

2. Advanced Semiconductor Engineering, Inc. is a corporation organized under the laws of Taiwan, Republic of China, and has a principal place of business at 26 Chin Third Road, Nantze Export Processing Zone, Kaohsiung, Republic of China.

3. ASE Test Limited is a corporation organized under the laws of Taiwan, Republic of China, and has a principal place of business at 10 West Fifth Street, Nantze Export Processing Zone, Kaohsiung, Republic of China.

4. ASE (U.S.) Inc. is a California corporation and has a principal place of business at 3590 Peterson Way, Santa Clara, California 95054.

5. On information and belief, Tessera is a Delaware corporation with its principal place of business in San Jose, California.

JURISDICTION

6. This Court has jurisdiction over this action, under 28 U.S.C. §§ 1338(a), 2201, and 2202, because this action arises under the patent laws of the United States, and is based upon an actual controversy between ASE and Tessera regarding the non-infringement and invalidity of the '106 Patent.

VENUE

7. Venue is proper in this Court pursuant to 28 U.S.C. §§1391(b) and (c). This district is the principal place of business for both Tessera and ASE (U.S.) Inc.

1 8. Personal jurisdiction and venue over Tessera are proper in this District as
2 Tessera markets and licenses its patent portfolio within this jurisdiction and has conceded
3 jurisdiction in concurrent litigation pending before Judge Wilken.

FACTUAL BACKGROUND

5 9. On September 2, 1997, the United States Patent Office issued the '106
6 Patent, entitled "Method of Encapsulating Die and Chip Carrier." The '106 Patent states on its
7 face that Tessera is its assignee. Exhibit A, page 1.

8 10. On August 1, 2008, Tessera informed ASE that Tessera intended to move to
9 add the '106 Patent to the pending International Trade Commission Investigation entitled *In the*
10 *Matter of Certain Semiconductor Chips with Minimized Chip Package Size and Products*
11 *Containing Same (IV)*, ITC Inv. No. 337-TA-649 (“the 649 Investigation”), alleging that ASE is
12 infringing the '106 Patent.

13 11. At present, the parties are involved in two separate cases: the 649
14 Investigation and a pending patent infringement case in United States District Court in the
15 Northern District of California, Case No. 05-4063 CW, before the Honorable Claudia Wilken.
16 Each case has multiple Patents in Suit and concern products similar to those products which
17 Tessera contends infringe the '106 Patent.

18 12. By reason of the foregoing, there is a justiciable controversy between ASE
19 and Tessera concerning non-infringement and invalidity of the '106 Patent.

20 13. ASE therefore seeks a Declaratory Judgment from this Court that ASE's
21 packaging services have not and do not infringe Tessera's '106 Patent, either directly, indirectly,
22 or otherwise.

23 14. ASE also seeks a Declaratory Judgment from this Court that Tessera's '106
24 Patent is invalid.

FIRST CLAIM FOR RELIEF

26 15. Plaintiff ASE realleges and repeats the allegations of paragraphs 1-14 as
27 through fully set forth herein.

1 16. ASE seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P.
2 57 and 28 U.S.C. §§ 2201 and 2202, declaring the '106 Patent to be not infringed by ASE, and
3 granting ASE all other declaratory relief to which it may be entitled.

SECOND CLAIM FOR RELIEF

5 17. Plaintiff ASE realleges and repeats the allegations of paragraphs 1-16 as
6 through fully set forth herein.

7 18. ASE seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P.
8 57 and 28 U.S.C. §§ 2201 and 2202, declaring that the claims of the '106 Patent are invalid for
9 failing to satisfy one or more requirements of the Patent Statute, including, without limitation, 35
10 U.S.C. Sections 101, 102, 103, 112, and 282.

PRAYER FOR RELIEF

WHEREFORE, ASE respectfully requests that the Court:

13 A. issue a Judicial Declaration that:

14 1. Advanced Semiconductor Engineering, Inc., ASE Test Limited, and
15 ASE (U.S.) Inc. have not infringed and are not infringing any claim of Tessera's United States
16 Patent No. 5,663,106, either directly, indirectly, or otherwise.

17 2. The claims of Tessera's United States Patent No. 5,663,106 are
18 invalid.

19 B. grant any and all equitable relief to which Advanced Semiconductor
20 Engineering, Inc., ASE Test Limited, and ASE (U.S.) Inc. are entitled;

21 C. award Advanced Semiconductor Engineering, Inc., ASE Test Limited, and
22 ASE (U.S.) Inc. all other and further relief to which they may be entitled; and

D. order such relief as the Court deems just and equitable.

JURY DEMAND

Advanced Semiconductor Engineering, Inc., ASE Test Limited, and ASE (U.S.)
Inc. demand a trial by jury of all issues triable of right by a jury.

1 Dated: August 4, 2008

2
3 THELEN REID BROWN RAYSMAN &
4 STEINER LLP

5 By 

6 Robert E. Camors, Jr.
7 Papool S. Chaudhari

8
9
10 Attorneys for Plaintiffs
11 Advanced Semiconductor Engineering, Inc., ASE
12 Test Limited, and ASE (U.S.), Inc.

13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28